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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/551,198

10/31/1995

FREDERICK S. HERZ

3864

23628

7590

07/13/2006

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EXAMINER

HUYNH, BA

ART UNIT

PAPER NUMBER

2179

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 08/551,198	<b>Applicant(s)</b> HERZ ET AL.	
	<b>Examiner</b> Ba Huynh	<b>Art Unit</b> 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 35-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,460,036; claim 1, 3, 4, 6-11, 13, 14, 16-27 of US patent #6,088,722; claims 1-13 of US patent 6,020,883; claims 1-6, 13-18, of US patent #5,835,087; claims 1- 22 of US patent 5,754,939; claim 1-36 of US patent 5,754,938. Although the conflicting claims are not identical, they are not patentably distinct from each other because the all directed to personalizing user content information by generating and correlating target profile and user target profile interest summary. Since there is large number of claims in each patent, mapping of limitations in each claim is not deemed productive. Applicant's cooperation is requested.

Claim 35-40 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/262,123. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because they are both directed to providing personalizing user content information by generating and correlating target profile and user target profile interest summary.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 45 depends on claim 1544 which does not exist.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,717,923 (Dedrick).

- As for claim 35: Dedrick teaches a method for providing a user with access to selected target objects ("electronic information") that are accessible via electronic storage media, wherein the user is connected via user terminal 12 and

target server 18 which includes the electronic storage media (fig. 1), comprising the steps of:

automatically generating target profiles (content database, 4:11-65) for the target stored in the storage media of server 18, each of the target profile being generated from the content of the target objects and their associated characteristic (4:16-18, 44-50),

automatically generating at least a user target profile interest summary (personal profile database, 5:34-66) for a user at a user terminal, each of the user target profile interest summary being generated from target profiles associated with at least one of the electronic information accessed by the user (5:34-49, 6:53-63, 7:10-35),

enabling user access to the stored electronic information via target profile and user profile (5:20-33, 6:34-52),

correlating the user target profile interest summary with the user profile to identify electronic information (5:27-29, 6:34-36),

transmitting a list of identified target objects to the user and allowing the user to select and retrieve desired target objects (9:11-24), the list is transmitted to the user prior to user selection of the information (8:20-46),

Dedrick fails to explicitly teach that the user selection and the retrieve information are transmitted over bidirectional connection. However since implementation of bidirectional communication connection is well known in the networking, and since Dedrick suggests client and server communicate in

both directions, it would have been obvious to one of skill in the art, at the time the invention was made, to implement the bidirectional communication connection to Dedrick for transmitting and receiving information. Motivation of the combining is for providing communication in both directions as suggested by Dedrick set forth above.

- As for claims 36, 37, 38: A list of identified target objects is transmitted to the user and allowing the user to select and retrieve desired target objects (9:11-24). Electronic information is transmitted to server 14, which is closer to the client computer (fig. 1). In light of the combining set forth above in claim 35, the information is transmitted over the bidirectional communication connection.
- As for claim 39: The user profile includes data indicating the number of page ("screen" of information) of the retrieved document accessed by the user (8:13).
- As for claim 40: The user target profile interest summary includes the length of time the user accessed a retrieved target object (8:1-13).

Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick as applied to claim 1 above, and further in view of Cutting et al (Scatter/Gather: A cluster-based Approach to Browsing large Document Collection).

- As for claim 41: A list of identified target objects is transmitted to the user and allowing the user to select and retrieve desired target objects (9:11-24). Dedrick fails to clearly teach sorting of the target objects based on similarity contents, and generating a hierarchical menu identifying a content in common

of target objects sorted into clusters. However in the same art of information retrieving, Cutting et al teach the method for sorting information into clusters based on similarity of its contents and presenting a hierarchical menu that identifies contents in common (page 319, "Scatter/gather browsing"; page 320, "Document Clustering"). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Cutting's clustering method to Dedrick for enabling a user to identify desirable target object. Motivation of the combining is for the advantage of being easier and more effective to retrieve information as expressly suggested by Cutting in the conclusion remarks (page 325).

- As for claim 42: The summary of the cluster is a profile having cluster attribute data to be considered by the user (page 319, col. 2, section 2). The profile is provided to each cluster produced during each successive clustering iteration (page 319, co. 2, section 2).
- As for claim 43: Target objects are divided and subdivided into multi-level hierarchy (page 319, "Scatter/Gather Browsing"; page 320, "Document Clustering").
- As for claim 44: The profile is provided to each cluster produced during each successive clustering iteration (page 319, co. 2, section 2).
- As for claim 45: Document clustering includes identifying of words (page 320, "Document Clustering").

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- As for claim 46: Target objects are sorted into cluster of target objects that closest to the center of the cluster of target objects (page 322, par. 4, “Definitions” and par. 5, “Partitional Clustering”). A cluster profile comprising a set of words contained in the target profile of a selected object which have the highest relative frequency (par. 4.1, “Cluster digest”).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

#### **REMARKS:**

The applicant must fully response to the Office action to avoid abandonment (MPEP 704.02). It is note that the applicant have acknowledged the Double Patenting rejection set forth in prior Office action however chose not to response to the rejection (the applicant’s argument, page 7, par. 1).

In response to the argument that the rejection fails to address the claimed steps (e)(2), (f) and (g) as recited in claim 35, the applicant is referred to the rejection set forth in the previous Office action. Specifically, Dedrick discloses transmitting a list of identified target objects to the user (step e1) and allowing the user to select and retrieve desired target objects (step e2). Thus there is a selection signal transmitted from the user terminal to the server (step f1), and a downloading of data from the server to the user terminal (step g). Dedrick fails to explicitly teach that the user selection and the retrieve information are transmitted over bidirectional connection. However since implementation of bidirectional communication connection is well known in the networking, and since Dedrick suggests client and server communicate in both



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directions, it would have been obvious to one of skill in the art, at the time the invention was made, to implement the bidirectional communication connection to Dedrick for transmitting and receiving information. Motivation of the combining is for providing communication in both directions as suggested by Dedrick set forth above.

In response to the argument that Dedrick does not teach “each of the target profiles being generated from the contents of an associated one of the target objects and their associated sets of target object characteristics”, the limitation is disclosed by Dedrick in col. 4, lines 11-67 wherein the server comprises a content database of electronic information (4:11-21), the target objects are identified and managed by target object characteristics (4:24-43, 6:35-42, 11:46-61). Thus the content database comprises target profile of electronic information associated with target object characteristics (e.g., user variables such as color preferences, age, sex, income). The target objects are further identified by their format (4:44-55).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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